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EXAMINER

DESIR, JEAN WICEL

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,116

Applicant(s)

NARUSHIMA ET AL.

Examiner

Jean W. Désir

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-20, 23-36 and 39-47 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 21, 22, 37, 38, 48 and 49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

NOTE: The rejections in the Office Action mailed on 4/1/03 are maintained. The rejections are repeated below. And a complete response to the Applicant's arguments is followed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 6-9, 12, 13, 17-20, 23-29, 30, 34-36, 39, 40, 44-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Garland (US 6,366,359).

Claim 1:

Garland discloses in Fig. 2:

"said receiver (items 202, 204, 212, 214), said display (item 208) and said printer (item 216) being connected to each other by way of a first signal transmission ^{212x} means for transmitting digital signals";

said receiver having :

"a reception means for receiving digital broadcasting (inherent to the system)";

"an imaging means (items 202, 212, 214) for generating video data by performing a predetermined imaging operation according to the received signals of digital broadcasting";

"and an output means (outputs of item 214) for transmitting the video data generated by said imaging means by way of said first signal transmission means";
said printer having:

"a reception means for receiving video data transmitted by said first signal transmission means; and a printing means for printing the images of the video data received by said reception means" (item 216).

Claim 2 is disclosed, see Fig. 2 items 212, 214.

Claims 6, 7 are disclosed, see Fig. 2 items 214, 208, 216.

Claims 8, 9 are disclosed, see Fig. 2 item 206.

Claim 12 is rejected for the same reasons as claim 1.

Claims 13, 17-20 are rejected for the same reasons as claims 2, 6-9.

Claim 23:

Garland discloses in Fig. 2:

"a reception means for receiving digital broadcasting (inherent to the system)";

"an imaging means (items 202, 212, 214) for generating video data by performing a predetermined imaging operation according to the received signals of digital broadcasting";

"and an output means (outputs of item 214) for transmitting the video data generated by said imaging means to a display (item 208) for displaying digital

Art Unit: 2614

broadcasting and a printer (item 216) for printing images contained in digital broadcasting by way of ~~said~~ first signal transmission means".

Claim 24 is disclosed, see Fig. 2 items 212, 214.

Claims 25, 26 are disclosed, see Fig. 2 items 214, 208, 216.

Claims 27, 28 are disclosed, see Fig. 2 item 206.

Claim 29 is disclosed, see Fig. 2 items 210, 206.

Claim 30:

Garland discloses in Fig. 2:

"a reception means (items 212, 214) for receiving the video data transmitted from said receiver to a display (item 208) for displaying digital broadcasting and to the printer (216) by way of a first signal transmission means for transmitting signals";

"and a printing means (item 216) for printing the images of the video data received by said reception means".

Claim 34 is disclosed, see Fig. 2 items 214, 208, 216.

Claims 35, 36 are disclosed, see Fig. 2 items 206, 210.

Claim 39 is rejected for the same reasons as claim 1.

Claims 40, 44-47 are rejected for the same reasons as claims 2, 6-9.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5, 14-16, 31-33, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garland (US 6,366,359) and Ito et al (6,529,522).

Claim 3: Garland discloses a printer as claimed, except Garland does not explicitly say that the printer includes a converting means. However, printer that includes converting means is a very well known procedure in the art in order to convert video data into data format suitable for printing (as evidence see for instance Ito at Fig. 3 items 202, 312); thus, an artisan would be motivated to combine the references to arrive at the claimed invention. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claims 4, 5 are disclosed, see Ito at Fig. 3 item 202, 313.

Claims 14-16 are rejected for the same reasons as claims 3-5.

Claims 31-33 are rejected for the same reasons as claims 3-5.

Claims 41-43 are rejected for the same reasons as claims 3-5.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicants argue that, on page 20 of the REMARKS, "Accordingly, in one aspect of claim 1, the receiver sends video data to the display and to the printer across one signal transmission means, so the printer receives the video data across the same connection as the display". And the Applicants continue arguing "Therefore, the Examiner's explanation appears to address a system where a display and a printer

Art Unit: 2614

not
receive data across respective connections, across the same connection as called for claim 1". These arguments are not persuasive; because Applicants argue limitations that are not in the claim, for instance, the subject matter "to the display and to the printer across one signal transmission means" and "the printer receives the video data across the same connection as the display" that the Applicants present in the arguments against the prior art are not in the claimed invention as argued by the Applicants. The limitations of claim 1 are broadly read over the prior art as explained in the rejection. Therefore, the rejection is maintained before the Office.

Applicants argue that, Regarding claim 6 on page 22 of the REMARKS, "However, it does not appear that the Examiner has explained how these items as shown in Figure 2 of Garland show that the printing means 216 receives display printing video data and printing video data and then extracts the printing video data. At a minimum, it does not appear that the Examiner has explained how these items Figure 2 show that the printing means 216 includes video extracting means as called for in claim 6". These arguments are not persuasive; because printing means 216 includes video extracting means as called for in claim 6: printing means 216 is a **video printer** which prints images of video data, so before printing these images, the printing means 216 has to extract the video data related to the images; in other words, video data extracting means as claimed in claim 6 is inherent to Garland's disclosure. Therefore, the rejection is maintained before the Office.

Applicants argue that, Regarding claim 8 on page 23 of the REMARKS, "However, it does not appear that the Examiner has explained how the synchronizing

means 206 as shown in Figure 2 of Garland shows two connections to the printing means having different data rate. At a minimum, it does not appear that the Examiner has explained how Figure 2 addresses data rates at all". These arguments are not persuasive; because Garland clearly shows in Figure 2 two ways to the printing means 216, one way for control signal (or code data or control data) and another way for video data, and they inherently have different data rates because one is for control data and the other is for video data; thus, Garland clearly anticipates claim 8 as claimed.

Therefore, the rejection is maintained before the Office.

Allowable Subject Matter

6. Claims 10, 11, 21, 22, 37, 38, 48, 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jean W. Désir** whose telephone number is **(703) 308-9571**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John W. Miller**, can be reached at **(703) 305-4795**.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306 0377.

JWD
Sep. 20, 03


MICHAEL H. LEE
PRIMARY EXAMINER